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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/345,820

06/30/1999

LYNN Y. SHIMADA

13065.36.1.1

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12/08/2006

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EXAMINER

COLBERT, ELLA

ART UNIT

PAPER NUMBER

3694

DATE MAILED: 12/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/345,820

Applicant(s)

SHIMADA, LYNN Y.

Examiner

Ella Colbert

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 November 2006 (interview).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10-14 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-14 and 17-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                                  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____   |

### **DETAILED ACTION**

1. Claims 10-14 and 17-21 are pending in this communication. This communication is in response to a telephone interview with Mr. Adam Stevens and fax on November 27, 2006.
2. The Non-Compliant (Miscellaneous communication to Applicant) mailed on 08/28/06 is hereby withdrawn as agreed in the telephone interview on 11/27/06 and in view of the new ground(s) of rejection as set forth here below.
3. The objection to the Specification has not been overcome because there are still remaining objections outstanding as set forth here below.

### ***Specification***

4. The Specification is objected to because on page 2 of the amendment to the Specification line 6 reciting entities as Checkfree, EDS, ...". The acronym "EDS" should be written like Commercial Off The Shelf (COTS). The acronyms "DDE" ( page 3 of the amended specification), "MICR" (page 9 of the original specification), "ACH" (original specification on page 10), and "DLL" (page 12 of the original specification). Page 16 of the original specification, line 22 recites "What is claimed is:". This recitation should be on the page at the beginning of the claims. Correction is required. See MPEP § 608.01(b).

### ***Claim Objections***

5. Claims 10, 12, 13, and 18 are objected to because of the following informalities: Claim 1, line 2 recites "owed to a ... the vendor utilizes an". This line would be better recited as "owed to a ... the vendor utilizes ". Claim 12, page 7, line 4 recites

"generating an ACH file ...". This line would be better recited as "generating an automated clearinghouse (ACH) file ...". Claim 13, page 8, line 3 recites "the vendor ..., wherein the financial institution is electronically". This line would be better recited as "the vendor ..., wherein the financial institution is". Claim 18, page 10, line 8 recites "of the user to ... the payment whens electronic payment exchange". This line would be better recited as "of the user to ... the payment when electronic payment exchange". Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

7. Claims 10-21 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added). Applicant's claims mentioned above are intended to embrace or overlap two different statutory classes of invention as set forth in 35 USC 101. The claims begin by discussing a method (ex. preamble of claims 10 and 18), the body of the claims discusses the specifics of the system of the payment amount, and subsequently the claim then deals with the specifics of a method (the steps) remitting, via the third-party electronic payment processing center, the amount to the vendor (see below the rejection of claims under 35 USC 112, second paragraph, for specific details regarding this issue). "A claim of this type is precluded by the express

language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only", Ex parte Lyell (17 USPQ2d 1548).

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 10-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular,

10. Claims 10-21 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular,

A. Claim 10 is not sufficiently precise due to the combining of two separate statutory classes of invention in a single claim. The preamble of the claim refers to a method, but the body of the claim discusses the specifics of the system of the payment amount owed (ex. a customer computer system), and subsequently the claim then deals with the specifics of a method (the steps ex. receiving, preprocessing, using, and remitting) the amount of the payment.

B. Claims 11-17 and 19-21 are rejected as being dependent on claims 10 and 18 as discussed above.

Art Unit: 3694

8. Claims 10 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: Claim 10, the first claim limitation should recite generating payment print data using an electronic accounting application for payment of the amount owed to the vendor, ...; transmitting payment print data using the electronic accounting application for payment of the amount owed to the vendor; receiving the transmitted payment print data at a print data reader, wherein the print data reader includes a check printing module ...; ...; (step is needed prior to "effecting the payment to the vendor by performing the steps of:" using "searching for data patterns in the transmitted payment print data"); ...; transmitting the electronic payment file from the electronic payment processing module to a third-party electronic payment processing center for effectuating the payment ...; and remitting, via the third-party ..., the amount owed to the vendor electronically where the vendor ...".

Claims 11-14, 17, and 19-21 are also rejected because of they depend from a rejected base claim.

### **Inquiries**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

Art Unit: 3694

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

December 5, 2006

  
ELLA COLBERT  
PRIMARY EXAMINER